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FETF 70625



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Clark et al.)
Appln. No.: 10/039,311)
Filed: 10/26/2001)
For: STERILIZATION OF)
PACKAGES AND THEIR)
CONTENTS USING LIGHT)
Group Art)
Unit: TBD)
Examiner: Not Yet Assigned)

PETITION IN RESPONSE TO NOTICE OF OMITTED ITEM(S)
IN A NONPROVISIONAL APPLICATION
UNDER 37 C.F.R. § 1.53(e)

Commissioner for Patents
Washington, D.C. 20231

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JUN 19 2002

OFFICE OF PETITIONS

Sir:

In Response to the enclosed Notice of Omitted Item(s) from the United States Patent and Trademark Office mailed on April 1, 2002, Applicants provide the following petition under 37 C.F.R. § 1.53(e) and include the appropriate petition fee under 37 C.F.R. § 1.17(h). Specifically, Applicants elect to take action pursuant to option (I) in the Notice of Omitted Item(s).

Applicants contend that Page 57, which includes Claims 18 through 25 (which are fully supported in the specification of the present application), was in fact deposited in the United States Patent and Trademark

Office with the nonprovisional application papers mailed on October 26, 2001.

Applicants submit herewith a copy of the Notice of Omitted Item(s) in a Nonprovisional Application.

Applicants also submit herewith a copy of Page 57 which includes Claims 18 through 25.

Applicants also submit herewith the Declaration of Thomas F. Lebens (hereinafter referred to as the Lebens declaration) and supporting Exhibits A-C as evidence indicating that Page 57 was in fact deposited in the United States Patent and Trademark Office on October 26, 2001. Thomas F. Lebens is the attorney who filed the present application.¹

As shown in the Lebens declaration and the Express Mail Mailing Label of Exhibit A, Applicants properly deposited the nonprovisional application papers with the United States postal Service by "Express Mail Post office to Addressee" in accordance with 37 C.F.R. § 1.10 on October 26, 2001.² Thus, all papers deposited in this submission should be accorded a filing date of October 26, 2001.

The MPEP provides in part that in response to a "Notice of Omitted Item(s)" the applicant can "promptly establish prior receipt in the USPTO of the page(s) at issue (generally by way of a date-stamped postcard receipt (MPEP § 503))."³

The MPEP also states that "a postcard receipt which itemizes and properly identifies the items which are

¹Lebens declaration, paragraph 3

²Lebens declaration, paragraphs 5-8 and Exhibit A

³MPEP § 601.01(d)

being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO."⁴ Additionally, the MPEP states that "if a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration."⁵ Furthermore, the person receiving the item(s) in the USPTO will check the listing on the postcard against the items(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO.⁶ If any items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.⁷

As provided in the attached Declaration of Thomas F. Lebens and the Return Receipt Postcard of Exhibit B, Applicants' Return Receipt Postcard clearly identified all parts of the application in accordance with the exact suggestion provided in MPEP § 503, i.e., identifying the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, and number of pages of

⁴MPEP § 503

⁵MPEP § 503

⁶MPEP § 503

⁷MPEP § 503

oath/declaration.⁸ The postcard of Exhibit B clearly identifies that the specification of 62 pages including 37 claims was deposited.⁹ It is submitted that the 62 pages of specification and 37 claims included page 57 with claims 18 through 25.¹⁰

As is clearly shown, the copy of the Return Receipt Postcard is date stamped October 26, 2001.¹¹ Furthermore, no items listed the Return Receipt Postcard are crossed off and initialed by the person receiving the submission in the USPTO.¹²

Therefore, in accordance with MPEP § 503, the Return Receipt Postcard of Exhibit B establishes *prima facie* evidence that page 57 with claims 18 through 25 was in fact deposited in the USPTO with the nonprovisional application on October 26, 2001.

Additionally, the declaration of Thomas F. Lebens outlines his standard procedure used for filing a nonprovisional application in the USPTO. This standard practice includes (1) counting the number of pages of the specification confirming that all pages are included and in proper sequence¹³ to verify the information listed on the Transmittal prior to signing the Transmittal and (2) counting all of the claims of the application to verify the information listed on the Fee Transmittal prior to

⁸Lebens declaration, paragraphs 9-13 and Exhibit B

⁹Lebens declaration, paragraph 13 and Exhibit B

¹⁰Lebens declaration, paragraph 16

¹¹Lebens declaration, paragraph 10 and Exhibit B

¹²Lebens declaration, Exhibit B

¹³Lebens declaration, paragraph 17

signing the Fee Transmittal¹⁴. The Utility Patent Application Transmittal of Exhibit C and the Fee Transmittal filed in the present application indicate that there are 62 pages of the specification and 37 claims.¹⁵

This standard practice also includes (3) counting all of the pages of the parts of the filing (including the number of pages of the specification) and comparing to that stated on the Return Receipt Postcard prior to initialing the Return Receipt Postcard¹⁶, (4) attaching the written description, drawings and Declaration/Power of Attorney together¹⁷ and (5) recounting the attached papers again verifying that the number of pages matches that indicated on the Return Receipt Postcard before the papers are placed and sealed in the Express mail envelope¹⁸.

Mr. Lebens has followed this practice since at least prior to the beginning of 2001.¹⁹ Therefore, based upon his standard practice and his detailed manner, Mr. Lebens is certain that page 57 with claims 18 through 25 was included with the nonprovisional application papers deposited with the United States Patent & Trademark Office on October 26, 2001.²⁰

¹⁴Lebens declaration, paragraph 18

¹⁵Lebens declaration, paragraph 15 and Exhibit C

¹⁶Lebens declaration, paragraph 19

¹⁷Lebens declaration, paragraph 20

¹⁸Lebens declaration, paragraph 21

¹⁹Lebens declaration, paragraph 23

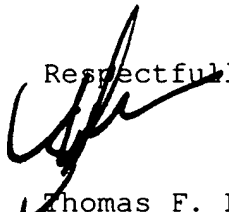
²⁰Lebens declaration, paragraph 24

CONCLUSION

Therefore, based upon the Return Receipt Postcard returned from the USPTO and the detailed standard practice of the attorney who filed the present application, Applicants have shown above that page 57 was in fact deposited with the United States Patent & Trademark Office on October 26, 2001. Thus, Applicants respectfully request and hereby petition that page 57, a copy of which is provided herewith, be placed in the file and accorded a filing date of October 26, 2001.

Should there remain any outstanding issues it is respectfully requested the office telephone the undersigned at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,



Thomas F. Lebens
Reg. No. 38,221

Dated:

May 24, 2002

Attachments: Copy of Notice of Omitted Item(s)
Copy of page 57 (Claims 18 through 25)
Declaration of Thomas F. Lebens
Exhibit A
Exhibit B
Exhibit C

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
Thomas F. Lebens
120 South LaSalle Street, Ste. 1600
Chicago, IL 60603
(858) 587-7641

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UNITED STATES PATENT & TRADEMARK OFFICE
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REQUEST FOR PATENT FEE REFUND											
1 Date of Request: <u>10-21-02</u>		2 Serial/Patent # <u>10/039,311</u>									
3 Please refund the following fee(s):		4 PAPER NUMBER	5 DATE FILED	6 AMOUNT							
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11 REFUND REQUESTED BY:											
TYPED/PRINTED NAME: <u>Steven Brantley</u>			TITLE: <u>Petitioner's Atty</u>								
SIGNATURE: <u>[Signature]</u>			PHONE: <u>306-5683</u>								
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APPROVED: <u>[Signature]</u>			DATE: <u>11/5/02</u>								

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